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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,856	07/28/2006	Shuya Kacchi	00862.110014.	9830
5514 7590 06/07/2010 FITZPATRICK CELLA HARPER & SCINTO 1290 Avenue of the Americas NEW YORK, NY 10104-3800				
EXAMINER				
PICH, PONNOREAY				
ART UNIT		PAPER NUMBER		
2435				
MAIL DATE		DELIVERY MODE		
06/07/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/587,856

**Applicant(s)**

KAECHI, SHUYA

**Examiner**

Ponnoreay Pich

**Art Unit**

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2010.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2 and 10 is/are pending in the application.  
4a) Of the above claim(s) 1, 3-9 and 11-19 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 2 and 10 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/GS-08)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date 7/06 and 12/08

### **DETAILED ACTION**

Claims 1, 3-9, and 11-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 4/9/10.

Applicant argues that the restriction requirement issued by the Office has been superseded by the memo by John Love issued on 4/27/07. Applicant argues that the memo requires the examiner in establishing serious burden to identify one of three reasons listed in the revised form paragraphs 8.01, 8.02, and 8.21, which was not done in the restriction requirement. Applicant states that the memo forbids the formulation of species based on a rationale that the claims to the different species recite the mutually exclusive characteristics of such species and that the restriction requirement made this precise rationale. These arguments are not persuasive.

The memo cited by applicant clearly states that the memo is "guidance", not that use of the form paragraphs are required. Also, contrary to applicant's assertions, form paragraph 8.01 was in fact used in making the election requirement and reasons for serious burden were discussed. Further, the memo does not forbid formulation of species based on a rationale that the claims to the different species recite the mutually exclusive characteristics of such species. Instead, the memo states that this language is inadequate in certain cases and it may be necessary to set forth additional details and/or different reasons to support the requirement for election. Assuming for the sake of argument, that the rationale that the claims to the different species recite the mutually

exclusive characteristics of such species was not adequate for the election requirement as set forth in the previous Office action, the Office action went on to specifically point out how each species differed from each other. A separate search for each of the eight different species discussed in the last Office action would be considered seriously burdensome by any reasonable individual. In arguing for withdrawal of the election requirement, applicant in essence is arguing that the examiner should do eight times the amount of work within the amount of time given to examine one normal patent application or volunteer the time necessary to do eight times the amount of work necessary to properly examine each species.

Applicant argues that the subject application is a national stage application filed under 35 USC 371, thus the USPTO is obligated to analyze the claims under unity of invention practice as described at MPEP 1893.03(d). The examiner respectfully submits that while MPEP 1893.03(d) sets forth the additional requirement that national stage applications have unity of invention, there is nothing in the cited portion which forbids election/restriction practice on top of the unity of invention requirement. In fact, it would appear that MPEP 1893.03(d)'s unity of invention practice does not supersede restriction practice, but rather is an additional requirement for applications filed under 35 USC 371.

As applicant's arguments have been traversed, only elected claims 2 and 10 were examined.

#### ***Information Disclosure Statement***

The IDS's submitted on 7/28/06 and 12/11/08 were considered.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 2 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Paddon et al (US 2005/0102517).

**Claims 2 and 10:**

As per claim 2, Paddon discloses:

1. Instructing means for instructing to start authentication processing in order to start communicating with a wireless communication device (paragraphs 20 and 22).
2. Transmission means for transmitting a search signal containing response time interval data by the wireless communication means when a start of authentication is instructed by said instructing means (paragraphs 20, 28 and 30).
3. Authentication means for, when a response signal is received by the wireless communication means from one wireless communication device at the response time intervals after the search signal is transmitted by said transmission means,

transmitting authentication information to the wireless communication device (paragraph 33).

The rejection of claim 2 applies, *mutatis mutandis*, to claim 10.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ponnoreay Pich whose telephone number is (571) 272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/

Application/Control Number: 10/587,856

Page 6

Art Unit: 2435

Primary Examiner, Art Unit 2435